

REMARKS

The Office examined claims 1-6 and 8-24 and rejected same. With this paper, the claims are changed to more distinctly claim the invention in response to suggestions by the Examiner, new claims 25-30 are added, and no claims are canceled. Thus, claims 1-6 and 8-30 are now pending.

Of the claims examined, the only claims 1 and 15 are independent.

Rejections under 35 USC §112, second paragraph

At section 4 of the Office action, claims 1-6 and 8-24 are rejected under 35 USC §112, second paragraph.

The Office first rejects the claims for reciting "information indicating a folder" in claims 1, 2, 5, 9 and 15, because such recitation allegedly renders the claims vague or indefinite. The Examiner asks whether the subject language is "information pointing to the location of a folder, information about the name of a folder, size of a folder, data units in a folder, etc." Applicant respectfully submits that "information indicating a folder" is clear on its face as any information sufficient to distinguish a particular folder from among other folders that are present or could be present. According to the Oxford Dictionary of Current English, Second Edition, the primary meaning of "indicate" is "point out; make known." To more distinctly claim the invention in this respect, applicant has amended claims 1 and 15 to recite that the information "uniquely identifies the folder."

Thus, "information indicating a folder" clearly encompasses "information pointing to a folder" and also encompasses the name of a folder and any path information needed to distinguish the folder from other folders of the same name, but does not include the size of the folder or data units in the folder, since such

information would not (always) be useable to "indicate" or "uniquely identify" the particular folder as opposed to other folders. Applicant concedes that of course it is possible that indicating the data units in a folder could indicate the folder, but only if no other folder had the same data units. Applicant respectfully submits that it is fair and reasonable for applicant to insist that "information indicating a folder" must mean only information that can always be useable to indicate/ uniquely identify a folder, and that with such an interpretation, and in view of the amendment to the claims to recite that the information "uniquely identifies the folder," the claim are not vague or indefinite.

The Office next rejects (in two respects, indicated as section 4b and 4c) the claims because claims 1 and 15 recite "information indicating the folder is placed in the message in an element or field." With this paper, claims 1 and 15 are changed in a way believed to obviate the rejections.

Finally, the Office rejects claim 8 for reciting "the protocol command element in combination with the data identification element indicates the folder." Applicant respectfully submits that one skilled in the art would understand claim 8 to be a teaching claim, to help understand claim 1 in case of a new folder to be added to the data store of the other device. Thus, the protocol command element could indicate that a folder is to be created, and the data identification element would indicate the name and location of the new folder (in e.g. a directory structure or other folder structure, e.g. in a record of a data base). Accordingly, applicant respectfully requests that the rejections under 35 USC §112, second paragraph, be withdrawn.

Rejections under 35 USC §103

At section 6 of the Office action, claims 1-24 are rejected

under 35 USC §103 as being unpatentable over Applicant Admitted Prior Art (AAPA) in reference to SyncML Initiative (including standards and specifications for SyncML, SyncML Representation Protocol, and SyncML Sync Protocol, SyncML Device Management Protocol).

Claim 1 recites that a first device prepares a message including information indicating a folder useable for storing data in a data store of the first device, with the message including a header and a body, each in turn comprising one or more elements, with the body elements useable for providing commands in connection with synchronizing the first data store with respect to a data store in another device and also useable for conveying data from the data store, and the information indicating the folder of the data store uniquely identifies the folder and is placed in the message in an element different from where data of the data store is placed or would be placed if included in the message.

Claim 15 is a corresponding apparatus claim.

Applicant respectfully submits that the invention as now claimed is clearly distinguished from AAPA in reference to SyncML Initiative. As pointed out in the application, at page 17, 11. 18-21, to make a change to a data unit, SyncML according to the prior art (what is referred to as AAPA above) "calls for a message referencing a data unit within a DATA element nested in an operational element." To reference the data unit, the DATA element must indicate the folder where the data is (or is to be placed, in case the data/folder are new), since SyncML Initiative provides no other basis for indicating the folder.

Claims 1 and 15, on the other hand, and as now changed to more distinctly claim the invention, require that the folder for such data (or a new folder) be indicated in "an element different from where data of the data store is placed or would be placed if

included in the message." The advantage provided by the invention is explained at page 17, line 21:

It is the use of a reference to affected folders external to the DATA element (i.e. a data description element) that gives the invention advantages over other possible arrangements for referring to affected folders (namely, not having to duplicate code enabling SyncML parsing by each application, and not having to include in each sync agent code for interpreting the data units of each different application).

The Office relies on the "SyncML Representation Protocol" for a teaching that "information indicating the folder of the data store is placed in the message in an element or field different from where data of the first data store is placed or would be placed if included in the message." However, applicant respectfully submits that there is no teaching in SyncML Representation Protocol that "information indicating the folder of the data store uniquely identifies the folder and is placed in the message in an element different from where data of the data store is placed or would be placed if included in the message," now recited in claims 1 and 15.

Applicant notes that the Office action at page 10, section 33, asserts that "the specification (page 9, lines 21-24) indicates that 'communicating changes in a data structure,' i.e. information indicating a folder, is not problematic in view of the prior art," which applicant understands as AAPA in combination with SyncML Representation Protocol. The Office then explains:

While this is not a statement that the limitation is taught or suggested by the prior art, it is clear indication that it would have been obvious to one skilled in the art at the time of the invention to use or modify such prior art in an obvious way in order to communicate changes in a data structure, specifically, when the application communicating the changes is the same as the application that creates or maintains the data contained in the folders. [Emphasis added.]

Applicant respectfully submits that first, in case the

"application communicating the changes is the same as the application that creates or maintains the data contained in the folders," there would be no motivation to indicate a folder "in an element different from where data of the data store is placed or would be placed if included in the message," because the application itself could make the changes to synchronize, as opposed to a sync agent, which would require duplicating code from the application in the sync agent (as explained at page 17, line 21, reproduced above). So the specific case mentioned is of no help in suggesting the invention.

Second, in order to reject a claim based on obviousness, there must in fact be "a statement that the limitation is taught or suggested by the prior art." The MPEP at 706.02(j) requires that reject a claim under 35 USC §103, the Examiner must establish a *prima facie* case of obviousness, which requires (among other things) that "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully maintains that AAPA, either alone or in combination with SyncML Representation Protocol, does not teach or suggest providing a message indicating a folder as in claim 1, i.e. in an element different from where data of the data store is placed or would be placed if included in the message. Further as provided by the MPEP at 706.02(j), any statement in applicant's disclosure *suggesting the invention* (as opposed to simply setting

out what the prior art is) cannot be used as a basis for rejecting claims based on obviousness. Applicant respectfully points out that the Office has not shown, and applicant insists cannot show, where in the prior art there is a teaching or suggestion of the invention, as required.

Accordingly, applicant respectfully requests that the rejections under 35 USC §103 of claims 1 and 15 be reconsidered and withdrawn, and similarly for the other claims now pending, in view of their dependencies.

New claims 25-30

Of the new claims, only claim 25 is independent, and recites the same limitations argued for claim 15. The other new claims depend from claim 25, and are thus believed allowable at least by virtue of their dependency.

Conclusion

For all the foregoing reasons it is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited. Applicant's attorney urges the Examiner to call to discuss the present response if anything in the present response is unclear or unpersuasive.

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Date

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